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RALPH E. JOCKE			POINVIL, FRANTZY	
Walker & Jocke				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/991,748	Applicant(s) ENRIGHT, JEFFERY M.	
	Examiner Frantzy Poinvil	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/22/2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/31/2010 has been entered.

2. Applicant's arguments filed 11/22/2010 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 6-15, 17-19, 21-27, 29-30, 33 and 35, are rejected under 35 U.S.C. 102(e) as being anticipated by Stinson (US Patent No. 6,149,056).

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As per claims 1, 17, 26-27 , 29-30, 33 Stinson et al disclose a system and method for providing an automatic check cashing system using biometric verification means. The system and method comprise:

(a) providing in an automated banking machine a document requiring a signature to achieve a legal effect (see the abstract);

(b) receiving at least one input from a user of the machine indicative that the user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user and acquiring the data corresponding to at least one image of the user through operation of the machine. See the abstract, column 7, line 30 to column 8, line 50 and column 9, line 35 to column 12, line 40.

The system of Stinson et al further includes at least one input device on the machine, at least one image acquisition device and at least one controller in operation with the data store. See columns 5-7 of Stinson et al. Stinson et al further teach a marking device operative to apply to the document indicia corresponding to the at least one image.

As per claims 6-8, and 33, Stinson et al disclose applying indicia or machine readable indicia from the user or signature of the user corresponding to the at least one image of the document or check wherein the indicia comprises a visual representation of at least a portion of the user, a visual representation of the user's face an image of the user's face, an image of a fingerprint of the user and an image of an iris of the user. See column 8, lines 11-44.

As per claim 9, Stinson et al disclose producing an electronic representation of at least one portion of the document with an imaging device in the system. See column 3, line 65 to column 4, line 4.

As per claims 10-11, 21-23 and 29-30, Stinson et al disclose storing in at least one data store, the electronic representation of the at least one portion of the document in' correlated relation with the data corresponding to the at least one image of the user and data corresponding to the at least one input in correlated relation with the data corresponding to the at least one image. See column 8, lines 11-50 and column 9, lines 35-64 and column 11, line 60 to column 12, line 39.

As per claim 12, Stinson et al disclose delivering the document from the machine to the user if the user does not endorse the check or document. See column 7, lines 55-65.

As per claim 13, Stinson et al disclose that the ATM machines can be used as a stand alone unit thereby being able to store the document therein. See column 5, lines 43-63.

As per claim 14 Stinson et al disclose the document comprises a negotiable instrument such as cash delivered by the user to the machine.

As per claims 15 and 18, Stinson et al disclose the user provides at least one input to the machine indicating that the data corresponding to the at least one image shall constitute endorsement of the negotiable instrument. See the abstract and column 7, lines 55-65.

As per claim 19, Stinson et al disclose that a check is received in the machine from the user. See columns 7-8.

As per claims 24-25, Stinson et al disclose the at least one image is acquired through operation of a camera or a biometric reading device. See column 8, lines 11-44.

As per claim 35, the ATM of Stinson includes a cash dispenser for dispensing cash.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5, 16, 20, 28, 31-32 and 34 and 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson et al (US Patent No. 6,149,056) as applied to claims 1, 15, 17, 19, 26 above in view of Norris (US Patent No. 5,940,811).

As per claims 2-5, the teachings of Stinson are discussed above. Stinson does not explicitly state applying indicia corresponding to the at least one image to the document. Norris discloses a closed loop system wherein a loan applicant applies for a loan using an Automated Teller machine without human intervention. See the abstract. Accordingly, Norris teaches providing a camera for capturing and indicia such as the image of the bank user or loan applicant and attaching the image onto the loan application. See column 7, lines 53-61 and column 3, lines 37-55 of Norris. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Norris into the system, method

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and computer program product of Stinson in order to relate an applicant to their loan application so as to deter fraud.

As per claim 16, Norris states (at column 3, lines 1-8) “an electronic signature pad to obtain the signature of the applicant indicating understanding and acceptance of the terms of the transactions”.

As per claim 20, Norris teaches applying indicia corresponding to the at least one image to a loan applicant, and suggesting doing the same on a check. See column 4, lines 39-47 of Norris.

As per claim 28, Norris teaches an electronic keypad to obtain the signature of the applicant and to apply the indicia onto the loan application.

As per claims 31-32, Norris also teaches capturing the image of the user and attached such onto the loan application.

As per claims 36-39, the electronic signature indicia comprises machine readable indicia. As per claim 36-49, the teachings of Stinson are discussed above. Stinson teaches providing an automated teller machine (ATM) for facilitating a bank customer to cash a check. See the abstract. The ATM includes a cash dispenser operative to dispense cash and a camera to capture the image of the user of the ATM. Stinson does not explicitly state “operating the machine to receive agreement from the user that at least one image of the user constitutes a legally binding electronic signature of the user for purposes of processing the check”. This teaching is provided by Norris. See column 3, lines 1-67 and column 8 of Norris. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of

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Norris into the system, method and computer program product of Stinson in order to allow assure that the bank customer or user understands the terms and conditions in executing a given transaction and also to positively identify the bank customer.

5. Claims 1-6, 9-24, 26-32 and 34-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris (US Patent No. 5,940,811).

As per claims 1, 17, 18, 19, Norris discloses a system, method and computer program product for providing a loan to a loan applicant from an automated teller machine (ATM).

Accordingly, Norris teaches:

- (a) providing in an automated banking machine a document requiring a signature to achieve a legal effect;
- (b) receiving at least one input from a user of the machine indicative that the user agrees that the user's electronic signature shall include data corresponding to at least one image of at least a portion of the user;
- (c) acquiring the data corresponding to at least one image of the user through operation of the machine.

Applicant is directed to column 3, lines 1-51 of Norris.

As per claims 2, 20, Norris discloses (d) applying indicia corresponding to the at least one image to the document. See column 3, lines 1-51 of Norris.

As per claims 3, 21, 22, 31, Norris discloses (d) the indicia comprises a visual representation of at least a portion of the user. See column 3, lines 1-51 of Norris.

As per claims 4, 32, Norris discloses (d) the visual representation comprises a visual representation of the user's face. See column 3, lines 1-51 of Norris.

As per claim 5, Norris discloses the indicia comprises machine readable indicia. See column 3, lines 1-51 of Norris.

As per claim 6, discloses the at least one image comprises an image of the user's face. See column 3, lines 1-51 of Norris.

As per claim 9, Norris discloses producing an electronic representation of at least one portion of the document with an imaging device in the machine. See column 7, lines 54-61 of Norris.

As per claims 10, 23 Norris discloses storing in at least one data store, the electronic representation of the at least one portion of the document in correlated relation with the data corresponding to the at least one image of the user. See column 8, lines 24-41 of Norris.

As per claim 11, Norris discloses storing in at least one data store, data corresponding to the at least one input in correlated relation with the data corresponding to the at least one image. See column 3, lines 34-51 of Norris.

As per claim 12, Norris discloses delivering the document from the machine to the user. See column 7, lines 54-61 of Norris.

As per claim 13, Norris discloses storing the document in the machine. See column 8, lines 24-41.

As per claim 14, Norris discloses (a) the document comprises a negotiable instrument delivered by the user to the machine. See column 4, lines 39-43 of Norris.

As per claim 15, Norris discloses (b) the user provides at least one input to the machine indicating that the data corresponding to the at least one image shall constitute endorsement of the negotiable instrument. See column 4, lines 25-39 of Norris.

As per claim 16, Norris discloses applying indicia corresponding to the at least one image to the document responsive to the at least one input received in step (b). See column 3, lines 44-51 of Norris.

As per claim 24, Norris discloses (c) the at least one image is acquired through operation of a camera. See column 7, lines 54-61 of Norris.

As per claim 26, Norris discloses a system, method and computer program product for providing a loan to a loan applicant from an automated teller machine (ATM). Accordingly, Norris teaches:

a document processing device in the machine operative to process a document for which a signature has legal effect:

at least one output device, at least one controller including software, wherein the controller is operative to cause the at least one output device to ask a user of the machine if the user agrees that image data corresponding to at least one imaged portion of the user shall constitute an electronic signature of the user for purposes of signing the document, at least one input device wherein the at least one input device is operative to receive from the user at least one user input indicating agreement by the user that the image data shall constitute an electronic signature of the user for purposes of signing the document;

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at least one image acquisition device wherein the at least one image acquisition device is operative to acquire the image data, wherein the at least one controller is in operative connection with the document processing device, the at least one output device, the at least one input device, and the at least one image acquisition device,

wherein the at least one controller is operative to cause the image data to be correlated with the document as the electronic signature of the user for the document.

Applicant is directed to the rejection of claim 1, column 4, lines 25-39 and column 7, lines 7, lines 44-61.

As per claim 27, Norris discloses a data store, wherein the at least one controller is in operative connection with the data store, wherein the controller is operative to cause data corresponding to the at least one user input to be stored in the data store in correlated relation with the image data. See column 8, lines 25-42 of Norris.

As per claims 28-30, Norris discloses an electronic pen and a camera. See column 3, lines 1-51 of Norris.

As per claim 34, Norris discloses an electronic pen wherein the indicia comprises machine readable indicia.

As per claim 35, see column 7, lines 38-53.

As per claims 36 and 37. See the rejection of claim 26 above.

As per claims 38-39, see column 8, lines 23-41.

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6. Claims 7-8, 25 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Norris (US Patent No. 5,940,811) as applied to claims 1, 17, 18 and 26 above in view of Stinson.

As per claims 7 and 8, and 25, the teachings of Norris are discussed above. Norris does not explicitly state the image comprises an image of a fingerprint or an iris of the user. The Examiner asserts that such would have been obvious to one of ordinary skill in the art as these are alternate types of biometrical data to identify a person. As such, in a similar environment, Stinson teaches providing a camera to be used to capture an image of a user. Stinson further teaches capturing the image of a fingerprint or iris of a user in the ATM. See column 8, lines 40-44 of Stinson. It would have been obvious to one of ordinary skill in the art at the time the invention was made to also include or substitute an image of a fingerprint or an iris of the user so as to obtain alternate identification of the user because the fingerprint or the iris of the user are more definite and almost unchangeable.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Frantzy Poinvil/
Primary Examiner, Art Unit 3691

/FP/
February 25, 2011